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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/894,520      | 06/27/2001  | James P. Kardach     | 42390P11689         | 5997             |

7590 04/04/2005

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EXAMINER

NGUYEN, KIMBERLY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2876

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/894,520  | <b>Applicant(s)</b><br>KARDACH, JAMES P. |  |
|                              | <b>Examiner</b><br>Kimberly D. Nguyen | <b>Art Unit</b><br>2876                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-16 and 18-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6, 8-16 and 18-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Acknowledgement is made of Amendment filed February 4, 2005.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8-16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Magnus et al. (WO 02/082359; hereinafter "Magnus").

Re claims 1-2, 5, 8-11, 13-14, 16, 18-21 and 23-24: Magnus teaches a method comprising:

printing a hardcopy representation (coupon 9 in fig. 2) of an electronic application on a paper having a printed pattern thereon (page 3, line 29 through page 4, line 10), the hardcopy representation having identification information to associate the hard copy representation with the electronic application, the identification information comprising an identification icon unique to the electronic application ("The coupons can, however, also be printed in and distributed by newspapers along with... Then it is possible to let the position-coding pattern be unique and identifiable to different newspaper publishers." (see page 4, lines 4-6)), wherein the "the position-coding pattern be unique and identifiable to different newspaper publishers" serves as an identification icon unique to the electronic application;

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recording one or more edits made with a pen on the hardcopy representation by recording movements of the pen with respect to the printed pattern (fig. 1; page 7, lines 16-34; page 9, line 16 through page 10, line 21); and

automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system (see figs. 2-3; page 7, line 15 through page 8, line 33; page 9, lines 16-35).

Re claims 3-4 and 15: Magnus teaches a method, wherein recording the information, such as winners, match results, number etc, comprises making a mark with the pen in the area/box with specific information (page 5, lines 1-3; page 8, lines 12-17; page 3, lines 8-17; page 5, lines 1-16).

Re claim 6 and 25: Magnus teaches a method, further comprising incorporating the one or more changes into the electronic version of the hardcopy representation automatically without end user intervention through the use of a pen/paper interface (page 7, lines 28-34).

Re claims 12 and 22: Magnus teaches locating position of the edits from camera images ("The camera communicates with a processor 5, in which the camera image is digitized and interpreted, and the image data is then stored in a memory 6" (see page 7, lines 25-28)).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-6, 8-16 and 18-25 have been considered but are moot in view of the new ground(s) of rejection.

5. In response to applicant's argument that "Claim 1 as amended sets forth "identification information to associate the hardcopy representation with the electronic application, the identification information comprising an identification (ID) icon unique to the electronic

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application" (claim 1, emphasis added). In contrast, Magnus fails to disclose "the identification information comprising an identification (ID) icon unique to the electronic application" (page 7, 3<sup>rd</sup> paragraph) and "Magnus discloses only a position-coding pattern, which is not the same as the ID icon set forth in claim 1" (page 8, lines 3-4), the examiner respectfully submits that "the position-coding pattern be unique and identifiable to different newspaper publishers" is broadly interpreted as an identification icon unique to the electronic application.

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN  
March 30, 2005



DIANE I. LEE  
PRIMARY EXAMINER